

REMARKS

Applicants wish to thank the examiner for taking the time on January 30, 2004 to discuss the pending Office Action. Reconsideration of the rejections set forth in the Office Action mailed November 3, 2003, is respectfully requested. Claims 1, 8, 10, 25, and 61 have been amended. Claims 1, 2, 4, 6, 8-10, 22, 23, 25, and 61 remain pending in this case. Support for this amendment can be found in the specification at, e.g., page 4, lines 9-17, page 5, lines 17-23, page 7, lines 19-23, page 21, line 23 – page 22, line 3, and page 23, lines 1-12. Therefore, these amendments are made without introducing new matter.

Information Disclosure Statement

As requested by the examiner, Applicants have provided the 3 articles cited in the PTO-Form 1449 that was submitted on March 8, 2001. Applicants respectfully request review of these articles and return of the initialed Form 1449 with the next correspondence.

In addition, Applicants note that the **PTO-Form 1449 submitted November 5, 2003** was not returned to Applicant with initials in the left-most column. Applicant respectfully requests that the Examiner return a copy of PTO-Form 1449 with the next correspondence.

Drawings

The examiner objected to Figs. 10A-10C as failing to comply with 37 CFR 1.84(p)(5) because they did not include reference to element 42. Applicants had mistakenly used element 42 to refer to both the proximal end (see page 16, line 15) and filter mesh 42 (see page 23, line 6). Applicants have amended the specification to refer to “filter mesh 45.” Element 45 has also been added to Figs. 10A-10C.

The examiner also objected to the specification as failing to comply with 37 CFR 1.84(p)(5) because it allegedly did not include reference to element 63. As discussed with the examiner over the telephone, Applicants respectfully point to page 22, lines 19-20, where the “filter 12 and sheath 60 also include, respectively, atraumatic tip 69 and 63 at their distal ends to minimize trauma to the vessel wall during their insertion.” (emphasis added) Therefore, Applicants respectfully request withdrawal of the objections and reconsideration of the specification as amended.

Claim Objections

Claims 8 and 10 have been amended to depend from claim 1. Therefore, Applicants respectfully request withdrawal of the objection and reconsideration of the claims as amended.

35 U.S.C. § 112

Claim 25 was rejected for allegedly having insufficient antecedent basis for “the tubular member” in line 16 of claim 25. Claim 25 has been amended to specify “the first and second tubular members.”

35 U.S.C. § 103

Claims 1-2, 4, 6, 8-10, 22-23, 25, and 61 were rejected over 35 U.S.C. § 103(a) as being allegedly unpatentable over Kaganov et al. (USP 5,876,367). Applicants have amended claims 1 and 25 to further include the step of “*contracting the filter by advancing a sheath distally.*” Claim 61 has similarly been amended to specify that “*the expandable filter is contracted by advancing a sheath distally over the expandable filter.*” Applicants respectfully assert that Kaganov does not teach or suggest the concept of contracting the filter by advancing a sheath distally. Moreover, Kaganov is

inconsistent with filter closure by advancing a sheath. In Kaganov, the filter would not contract by advancing a sheath distally over the filter because there are no struts that extend proximally that would be compressed by movement of the sheath distally. Therefore, Applicants respectfully request withdrawal of the rejection and reconsideration of the claims as amended.

Applicants submit that the claims, as amended, are free of the cited art and are in position for allowance. Please charge Deposit Account No. **50-2862** for the 1-month extension fee and any other fees required by this submission. If the Examiner has any questions regarding this communication, or feels that an interview might facilitate prosecution of the application, he is invited to contact the undersigned at (949) 737-2900.

Respectfully submitted,
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Dated: March 2, 2004

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